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DATE: SEPTEMBER 29, 2006

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Confirmation #:

Examiner Niloofar

United States Patent and Trademark Office/Group 1600

571-273-4329

Rahmani

From:

Kurt Briscoe

Number of Pages:

15

Client/Matter Name:

USSN 10/669,424

Client/Matter Number:

104093-8

Frank Berendes et al.

Dear Examiner Rahmani:

As discussed your page 10 of the amendment dated August 1, 2006, is incomplete. You are also missing pages 11 and 12 of that same amendment. A complete copy of the entire amendment of August 1, 2006, is attached, along with the Auto-Reply Facsimile Transmissions showing all 12 pages of the amendment were received by the Patent Office on August 1, 2006

The original document will be sent via:		
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USPTO 8/1/2006 9:16 PM TO:Auto-reply fax to 9737930320 COMPANY:

PAGE 1/001 Fax Server

Auto-Reply Facsimile Transmission



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IN TO	F UNITED STATE	ES PATENT AND TRADEMARK OPE	
APPLICANT :	Frank BERENDI		
SERIAL NO. :	10/669,424		
CUSTOMER NO.:	27384		
FILED :	September 24, 20	003	
FOR :	BBOVESS FOR	PREPARING 3-HETEROARYI, 3-	
, ,	HYDROXYPRO	PANOIC ACID DERIVATIVES	
ART UNIT :	1625		
EXAMINER :	Nikoofer Ratmen	ní	
		August 1, 2006	
Commissioner for J PO Bex 1450	Petents	3-4-11-4	
Alexandria, VA 22	313-1450		
	AMENDM	ENT UNDER 37 CFR § 1.111	
SIR.			
		a dated May 1, 2005, please amend the a	bove-idendified
application as follo-	ns.		
Amendments to th	e Claims are reflect	ted in the listing of claims which begins	
paper.		are in the usung in course when begins	on page 2 of this · ·
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In view of the foregoing. Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Chairms 10-16 were rejected under 35 USC § 112, first paragraph, as being broader than the enabling disclosure in embracing compounds whereir, heterozryl is a 7 to 10-mombered ring. In response, Applicants point out that examples of species meeting this definition are set forth at page 6, lines 18-19, namely induly), induzohy), benzofurany), benzothiopheny), quinoliny) or isoquinoffey! Further the presence or absence of working examples is only one factor to be taken into consideration in determining enablement. The fixaminer has given so reason, other than the absence of working examples, why a person skilled in the art should not be able to practice the full scope of the invention as elabraed. Indeed, the fixaminer takes the position in connection with the obviousness rejection that the choice of intercompt would not be expected to affect the course of the reaction. This is completely at odds with the notion that the beterrary) group is somehow critical, thereby requiring working examples in order for a person akilied in the art to practice the invention. In the absence of such reason, the Examiner has not made out a

Respectfully, this rejection is untenable, and Applicants respectfully request that the Examiner reconsider and withdraw it as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 10-16 were rejected under 35 USC § 112, first paragraph, as being broader than the orabling disclosure in embracing compounds wherein W is CN. In response, Applicante point out that fixemple 3 at the bottom of page 21 describes an example wherein $W\sim CN$.

USSN 10/669,424 Amendment under 17 CPR § 1.111 filed August 1, 2066

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